

### **REMARKS**

Claims 1-9, 11-38, 40, 50, 55, 60, and 80-87 are pending. Claim 55 is withdrawn from consideration. Claims 1, 6, 23, 31, 38 and 60 have been amended herein. Claim 50 is allowable. No new matter has been added with the Amendments, being fully supported by the specification and claims as originally filed. Upon entry of this communication, claims 1-9, 11-38, 40, 50, 60, and 80-87 will be under consideration.

### **Objections**

Claim 60 is objected to for reciting "a" instead of "α." Claim 60 has been amended to recite "α." Applicants request withdrawal of the objection.

### **Rejections under 35 U.S.C. § 112, First Paragraph**

#### *Enablement*

Claims 1-9 and 11-22 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make or use the invention. Specifically, the Examiner alleges that "decreasing" the stability of the reporter moiety, as recited in claim 1, is not enabled by the specification. While Applicants traverse this rejection, it is noted that claim 1 has been amended to recite "increasing" the stability of the reporter moiety. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are requested.

The Examiner further alleges that without a clear description of the ubiquitin "homologs" encompassed by the claims, one of skill in the art would not know how to make or use the claimed invention without performing additional experimentation. Applicants traverse this rejection and submit that definition of "homolog" provided at pages 13-14 of the specification and the discussion regarding destabilization domains and the functionality thereof is sufficient to satisfy the Written Description and Enablement requirements of 35 U.S.C. § 112, first paragraph.

Nevertheless, Applicants note that claims 6, 31 and 38 have been amended to recite a ubiquitin homolog having an amino acid sequence at least 85% identical to the amino acid sequence of wild-type ubiquitin. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are requested.

*Written Description*

Claims 1-9, 11-38, 40 and 80-87 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants traverse the rejection.

Applicants maintain that the definition of "homolog" provided at pages 13-14 of the specification and the discussion regarding destabilization domains and the functionality thereof is sufficient to satisfy the Written Description and Enablement requirements of 35 U.S.C. § 112, first paragraph. However, in order to expedite allowance of the pending claims, Applicants have amended claims 6, 31 and 38 to recite a ubiquitin homolog having an amino acid sequence at least 85% identical to the amino acid sequence of wild-type ubiquitin. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are requested.

In re Application of:

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Application No.: 09/498,098

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### **CONCLUSION**

In view of the amendments and the above remarks, it is submitted that the claims are in condition for allowance and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

Applicants have enclosed a check number 571203 in the amount of \$110.00 for the one-month extension fee with this submission. Applicants do not believe any other fees are due in connection with this submission, however if any other fees are due, please charge any fees, or make any credits, to Deposit Account No. 07-1896.

Respectfully submitted,

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Michael P. Reed  
Reg. No. 45,647  
Attorney for Applicant  
Telephone: (858) 638-6754  
Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP  
4365 Executive Drive, Suite 1100  
San Diego, California 92121-2133  
USPTO CUSTOMER NUMBER 28213